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Paper No. 34

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OFFICE OF PETITIONS

In re Application of
Miltenyi, et al.
Application No. 08/416,920
Filed: April 21, 1995
Attorney Docket No. 212302000320

DECISION ON PETITION

This is a decision on the combined petition filed August 21, 2000, pursuant to 37 C.F.R. §1.137(b), to revive the above-identified application, and pursuant to 37 C.F.R. §1.183, to waive the requirement of §1.137(b)(4) for a terminal disclaimer. The application file was recently forwarded to the Office of Petitions for consideration of the petition¹.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely file a proper response to the Nonresponsive Letter mailed September 2, 1998². A supplemental amendment was filed on September 16, 1998, purportedly correcting the deficiencies noted in the Nonresponsive Letter. However, in a final rejection mailed July 20, 1999, the examiner noted that the previously cited deficiency in claim 20 still needed to be corrected. Accordingly, it is concluded that the response filed September 16, 1998 was not fully responsive and the above-identified application became abandoned on October 3, 1998, by operation of law. The present petition precedes the mailing of a courtesy Notice of Abandonment.

The abandoned status of the application was not made of record and prosecution in the application continued. On January 20, 2000, applicant replied to the final rejection with both an amendment under 37 CFR 1.116 and a Notice of Appeal. In an advisory action mailed March 17, 2000, applicant was advised *inter alia* that the amendment would not be entered, the final rejection stood, and that an appellant's brief in accordance with §1.192(a) was due. On August 21, 2000, applicant filed the instant petition along with *inter alia* 1) a request for removing the finality of the July 20, 1999 Office action pursuant to 37 CFR §1.129(a); 2) an amendment under §1.129; and 3) a petition for a five-month extension of time. The petition was not

¹ On August 23, 2001, petitioner contacted the Office of Petitions regarding the status of the petition, and submitted a copy thereof by facsimile transmission.

² Consistent with Office practice at the time, the Nonresponsive letter mailed September 2, 1998, should have set a 30 Day period for reply. This omission is not significant, in that, the examiner did consider the reply to the letter filed September 16, 1998.

forwarded to the Office of Petitions for consideration. But, in an Office action mailed January 16, 2001 (remailed February 14, 2001), the finality of the July 20, 1999 Office action was withdrawn, and applicant's first submission after final filed on October 30, 2000, was entered.

As prosecution has continued, this petition is being considered to close the gap in prosecution. Petitioner has met the requirements for a grantable petition under §1.137(b). The petition as filed included the petition fee and the required statement of unintentional delay. The Notice of Appeal previously filed January 20, 2000, is accepted as the reply required under §1.137(b)(1)^{3,4}. Under the circumstances of the abandonment of this application, petitioner's request for waiver of the requirement for a terminal disclaimer is granted.

This application is being returned to Technology Center 1600 for examination. This decision in no way tolls the period for reply to any outstanding Office action or requirement.

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-0309.



Nancy Johnson
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

³ As the amendment under §1.116 filed January 20, 2000, did not place the application in condition for allowance, it does not satisfy §1.137(b)(1).

⁴ However, the subsequent timely filing under §1.129 served to withdraw the Notice of Appeal and eliminate the requirement to file an Appeal Brief.